

REMARKS

The Office Action dated June 20, 2003 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

The Examiner relies on Angles ('811) under 35 USC 102(e) for claims 1 and 2. Angles was discussed at pages 5 and 6 of the instant patent application as filed. It is no more relevant now than then.

Angles merely provides peripheral "custom ads" (abstract) mandated by a consumer profile generated by a consumer's other web requests (Fig. 3). Applicant's ads are the very subject matter of the web request.

Claims 1 and 2 are amended to make more explicit what was apparently implicit heretofore and unappreciated by the Examiner. The two mediums are now specified and claimed as being different and unlike Angles.

The Angles patent is based upon the premise that a profile of a web user and/or shopper is developed based upon visits to certain web pages or the result of web searches/inquiries. Based upon the profile that is created and stored in some central database, customized advertisements are then directed to that web user/shopper for his/her review and perusal. This is done whether the web user/shopper asks for the advertising or not. Along those lines, the 'pusher' of such advertising collects, amasses and modifies the user's profile over time based upon a cookie system so that the ads become more specialized.

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

"... anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference." *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, "those elements must either be inherent or disclosed expressly . . ." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). "... and must be arranged as in the claim[s] . . ." *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, "... [the] absence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. § 103 which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashcinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 437 F.2d 1044 (Fed. Cir. 1988).

These precedents, which are recent decisions from the Court of Appeals for the Federal Circuit are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

The Dedrick patent was somewhat similar to Angles in that it too uses demographic information that it gathers or accumulates on the web to target its advertising to those people. One difference is that Dedrick prints out the advertisement from the computer. This is not a newspaper.

Dedrick merely causes an electronic ad to be carried on a video signal where there contains no information (vertical blanking interval). Subsequently an end user can print the ad.

The Examiner has merely found a reference with some words missing in Angles. A common dictionary has all the words, but neither the motivation nor teaching is present.

To rephrase - applicant delivers newspaper ads to the internet to extend the useful life of the ad and to expose the ad to people who do not use newspapers.

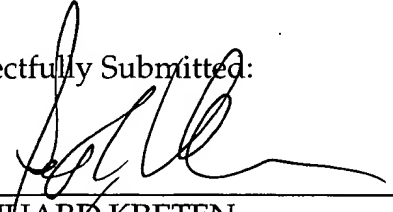
New claims are included which represent these concepts along with other warranted by the state of the art.

The Examiner is respectfully requested to note that the Office Action to which this amendment responds was mailed on June 20, 2003, thereby requiring a response on December 20, 2003. December 20, 2003 was a Saturday. Therefore this amendment is timely filed on Monday, December 22, 2003.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Respectfully Submitted:



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